

Remarks

The above Amendments and these Remarks are in reply to the Notice of Non-Compliant Amendment mailed April 9, 2007.

Claims 10 and 11 have been amended to include the correct status identifier. The corrected section of the amendment filed on March 30, 2007, including a complete listing of all claims, has been provided in compliance with 37 C.F.R. 1.121.

The Remarks section of the non-compliant amendment is also submitted herewith, corrected to include a reference to amended claims 10 and 11.

I. Summary of Examiner's Objections/Rejections

Claims 1-24 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-24.

Claim 23 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim 22 was rejected under 35 U.S.C. 112 as containing a limitation lacking sufficient antecedent basis.

Claims 1-10, 12, 14-18, and 22-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Boehme et al. (U.S. Pat. No. 6,578,191).

Claims 11 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boehme et al. in view of Cohen et al. (U.S. Pat. No. 6,011,918).

Claims 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boehme et al. in view of Stapp et al. (U.S. Publication. No. 2004/0015832).

II. Summary of Applicant's Response

The present Reply cancels claims 22-24, amends claims 1, 10 and 11, and adds new claim 25, leaving for the Examiner's present consideration claims 1-21 and 25. Reconsideration of the rejections is requested.

III. Response to Rejections

Claim 1 as amended states:

A dynamic code generation method, comprising:
creating a class file container object;
adding a method to the class file object;
adding code to the method using programming language constructs;
generating byte code for the class file container object;
instantiating an instance of the new class file object;
a class loader generates executable code from the byte code; and
wherein the dynamically generated code would be configured to exist for the life of a server it resides upon.

Claim 1 defines a dynamic code generation method. The dynamically generated code is configured to exist for the life of a server the dynamically generated program code resides upon.

In this response, Claim 1 is amended by the features that were previously in claim 23. In discussing claim 23, the Office Action acknowledged that Boehm does not disclose the limitation of the “dynamically generated code would be configured to exist for the life of the server it resides upon.” The office action alleged that these features would be inherent to Boehm. However, Boehm states “[t]he classes and objects need only exist at the time that a running application calls for the adapter classes, and can be dynamically modified or exchanged in order to optimize the running application or modify application functionality” (col 3, lines 4-8). By stating that the classes and objects only need to exist when the running application calls for them, Boehm does not support the

assertion of inherent characteristic status for “the generated code would exist for the life of the server.”

Boehm does not support the Office Action’s assertion of an allegedly inherent characteristic. MPEP Section 2112, *Requirements of Rejection Based on Inherency; Burden of Proof*, provides that “A rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic.” Yet here, Boehm is not silent, instead Boehm does not support the allegedly inherent characteristic. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action does not provide a basis in fact or technical reasoning for supporting the determination that the allegedly inherent characteristic necessarily flows from Boehm.

Dependent Claims 10 and 11 were amended to better describe embodiments of applicant’s invention.

Dependent Claims 2-21 and 25 are believed to be patentable for reasons similar to those discussed above with Claim 1. It is also submitted that Claims 2-21 and 25 also add their own limitations which render them patentable in their own right. Applicant reserves the right to argue these limitations should it become necessary in the future.

Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting

issuance of a patent.

No fee is believed due with this communication, however the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: April 19, 2007

By: /Thomas K. Plunkett/
Thomas K. Plunkett
Reg. No. 57,253

Customer No. 23910
FLIESLER MEYER LLP
650 California Street, 14th Floor
San Francisco, California 94108
Telephone: (415) 362-3800
Facsimile: (415) 362-2928